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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,932	02/08/2002	Robert J. Nordstrom	MDS-022C1	1037
51414	7590	06/27/2007		
GOODWIN PROCTER LLP PATENT ADMINISTRATOR EXCHANGE PLACE BOSTON, MA 02109-2881			EXAMINER ROY, BAISAKHI	
			ART UNIT 3737	PAPER NUMBER
			MAIL DATE 06/27/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/071,932

Applicant(s)

NORDSTROM ET AL.

Examiner

Baisakhi Roy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 24, 26-34, 36-38, 40-44, 46, 47, and 49-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24, 26-34, 36-38, 40-44, 46, 47, and 49-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION*****Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 24, 26-34, 36, and 37 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-39 of copending Application No. 10/099,881. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in '881 directed to screening/classification of cervical tissue using fluorescence and reflectance data anticipates the method claims in current application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 24, 26-34, 36, and 37 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-48

of copending Application No. 10/418,415. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in '415 directed to screening/classification of cervical tissue using fluorescence and reflectance data anticipates the method claims in current application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 24, 26-34, 36, and 37 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-41 of copending Application No. 10/295,794. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in '794 directed to screening/classification of cervical tissue using fluorescence and reflectance data anticipates the method claims in current application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 24, 26-34, 36, and 37 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-46 of copending Application No. 10/418,922. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in '922 directed to screening/classification of cervical tissue using fluorescence and reflectance data anticipates the method claims in current application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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6. Claims 24, 26-34, 36-38, 40-44, 46, 47, and 49-52 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-61 of copending Application No. 10/530,741. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in '741 directed to screening/classification of cervical tissue using fluorescence and reflectance data anticipates the method claims in current application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 24, 26-34, 36-38, 40-44, 46, 47, and 49-52 are rejected under 35 U.S.C. 102(e) as being anticipated by Utzinger et al. (6766184). Utzinger et al. disclose a method and apparatus of classifying cervical tissue by generating multispectral images of the cervix these images may include images of fluorescence, reflectance, polarized reflectance, or any combination (col. 3 lines 32-43). The system includes illumination source 15 for use in fluorescence excitation, where the illumination fibers may be configured to select one or more wavelengths of illumination radiation (col. 4

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lines 63 – col. 5 line 39). The system includes illumination source 14 while generating reflectance data (col. 5 lines 40-58). Utzinger et al. teach the combination of fluorescence and reflectance tests to enhance diagnostic accuracy since fluorescence may be sensitive to tissue metabolism while reflectance may be sensitive to tissue structure (col. 6 lines 52-65). The reference teaches the collection of fluorescence as an initial screening tool and then further enhancing the diagnostic procedure by collecting reflectance data (col. 12 lines 7-21). Utzinger et al. teach obtaining additional optical information such as video information and optical images (col. 5 lines 59 – col. 6 lines 26). Pre-cancerous, cancerous, and many other cervical tissue conditions are screened/diagnosed (col. 11 lines 46-54).

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO 892 for relevant references of interest.

6,537,211 – system and method directed to obtaining fluorescence and reflectance images of tissue of interest.

6427082 – fluorescence based system and method for distinguishing between healthy and diseases cervical tissue.

6507747 – method and apparatus for structural and biochemical characterization of tissue.

6421553 – system and method of tissue classification

6505059 – system and method of monitoring glucose level using fluorescence and reflectance data.

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6364829 – system and method of imaging tissue autofluoresence.

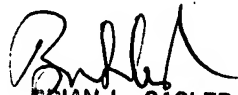
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Baisakhi Roy whose telephone number is 571-272-7139. The examiner can normally be reached on M-F (7:30 a.m. - 4p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian L. Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BR

BR

  
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